

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed October 11, 2005. In order to advance prosecution of this case, Applicants amend Claims 16, 30, 58, and 61. Applicants cancel Claims 28 and 29 without prejudice or disclaimer. Applicants previously cancelled Claims 1-15, 17, 19, 25-27, 42-49, and 52 without prejudice or disclaimer. Applicants respectfully request reconsideration and favorable action in this case.

Allowable Subject Matter

Applicants note with appreciation the Examiner's allowance of Claims 53-54.

Section 102 Rejections

The Examiner rejects Claims 16, 18, 22-23, 55-59 and 61 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,377,570 issued to Vaziri et al. ("Vaziri"). As amended, Claim 16 recites:

A method for establishing voice communication between a first station and a second station, the method comprising the steps of:

receiving, at a second station, a code transmitted by a first station, wherein the code uniquely identifies the first station;

establishing a communication channel between the first station and a data network having a network server, the network server assigning a data network address to the first station;

identifying, at the second station, the data network address of the first station based at least in part upon the code;

storing the code and the data network address into a memory;

retrieving, at the second station, the data network address of the first station by searching the memory for the code;

determining whether the first and second stations can support a communication channel for voice communication over the data network; and

establishing a communication channel between the first station and the second station for voice communication over the data network, using the data network address of said first station, if the first and second stations can support a communication channel for voice communication over the data network.

Vaziri fails to recite, expressly or inherently, every element of Claim 16 for at least several reasons. First, *Vaziri* fails to disclose "receiving, at a second station, a code transmitted by a first station." Second, *Vaziri* fails to disclose "identifying, at the second

station, the data network address of the first station based at least in part upon the code.” For at least these reasons, as described in greater detail below, *Vaziri* fails to recite every element of Claim 16.

First, *Vaziri* fails to disclose “receiving, at a second station, a code transmitted by a first station.” The portion of *Vaziri* cited by the Examiner in rejecting this element of Claim 16 states only that:

In the MMIC, both users dial #2 to access MMIC operation in their ISBs via the menu. *User A enters user B's number*, which user A's ISB verifies in its directory, and user A's ISB enters MMIC-caller mode. *User B enters user A's number*, which user B's ISB verifies in its directory, and user B's ISB enters MMIC-called-party mode.

Col. 17, ll. 32-37, emphasis added.

Thus, in the system of *Vaziri*, each user enters, at his or her ISB, the number of the other terminal. Consequently, one ISB does not receive, from the other ISB, the number of the other ISB. As a result, *Vaziri* does not disclose “receiving, at a second station, a code transmitted by a first station.”

Second, *Vaziri* fails to disclose “identifying, at the second station, the data network address of the first station based at least in part upon the code.” The portion of *Vaziri* cited by the Examiner discloses only that:

In steps 512 and 514, each party's ISB sends the calling and called telephone numbers and that ISB's IP address to the ISBSS. In step 516, each party gets the other party's IP address from the ISBSS, and in step 518, the parties talk via IT.

Col. 13, ll. 61-65.

Thus, each party's ISB retrieves the other ISB's IP address from the ISBSS. Each ISB is not configured to identify, at the ISB, the data network address of the other ISB. Thus, *Vaziri* does not disclose “identifying, at the second station, the data network address of the first station based at least in part upon the code.”

Third, *Vaziri* fails to disclose “determining whether the first and second stations can support a communication channel for voice communication over the data network” and “establishing a communication channel between the first station and the second station for voice communication over the data network, using the data network address of said first station, if the first and second stations can support a communication channel for voice

communication over the data network.” The portion of *Vaziri* cited by the Examiner in addressing this element states only that:

[E]ach ISB sends the ISBSS a connection request . . . The ISBSS searches for a match between the ISB and a waiting list of ISB’s. If there is not match, as in step 9A06, (where caller A’s request has been received first), the ISB is appended to the waiting list or queue in step 9A08 and is instructed by the ISBSS to expect a call from another ISB. If there is a match, as in step 9A10 (where caller B’s request has been received second), the ISB matches the requests in step 9A12 to find the IP address of the other party’s ISB in step 9A14. In step 9A16, the ISBSS forwards caller A’s IP address to caller B’s ISB, and in step 9A18, caller B’s ISB attempts to contact caller A’s ISB using the thus obtained IP address, whereupon the ISBSS has no more involvement in the call.

Col. 19, ll. 12-25.

Thus, a first ISB transmits a connection request to the ISBSS, and the ISBSS attempts to match the request from the first ISB to a previously received request from a second ISB. If the ISBSS successfully matches the request, ISBSS forwards the IP address of the second ISB to the first ISB. Nonetheless, ISBSS does not “determin[e] whether the first and second stations can support a communication channel for voice communication over the data network” as recited by Claim 16. Additionally, the first ISB attempts to contact a second ISB based on whether the ISBSS successfully matches the request from the first ISB to a previously-received request from the second ISB and not based on whether the first ISB and the second ISB can support a communication channel for voice communication over the data network. Consequently, the ISBSS also does not “establish[] a communication channel between the first station and the second station for voice communication over the data network, using the data network address of said first station, if the first and second stations can support a communication channel for voice communication over the data network.” Thus, *Vaziri* fails to disclose “determining whether the first and second stations can support a communication channel for voice communication over the data network” and “establishing a communication channel between the first station and the second station for voice communication over the data network, using the data network address of said first station, if the first and second stations can support a communication channel for voice communication over the data network.”

As a result, *Vaziri* does not recite, inherently or expressly, every element of amended Claim 16. Claim 16 is thus allowable for at least these reasons. Applicants respectfully request reconsideration and allowance of Claim 16 and its dependents.

Although of differing scope from Claim 16, Claim 58 includes elements that, for reasons substantially similar to those discussed with respect to Claim 16, are not recited by *Vaziri*. Claim 58 is thus allowable for at least these reasons. Applicants respectfully request reconsideration and allowance.

The Examiner rejects Claim 28 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,944,151 issued to Ménard (“*Ménard*”). For the purposes of expediting prosecution, Applicants cancel Claims 28 and 29 without prejudice or disclaimer. Applicants wish to note that, with respect to all cancellations and amendments herein, Applicants reserve the right to pursue broader subject matter than that presently claimed through the filing of continuations and/or other related filings.

With respect to Claim 55, the Examiner notes “Claim 55 is similar to claims 16 and 18. Therefore, claim 55 is rejected with the same rationale as claims 16 and 18.” *Office Action*, p. 4. Moreover, with respect to Claim 18, the Examiner contends that “*Vaziri* inherently discloses determining whether the code is invalid; and disconnecting the communication channel between the first station and the data network if the code is invalid (after established the communication channel, the user of first station said wrong number, then the system will disconnect the communication channel after the first station hang-up).” *Office Action*, p. 3. Applicants respectfully contest this assertion and note that the Examiner has provided no citation for any discussion of the operation of the *Vaziri* system in response to a “wrong number.” *Vaziri* in fact does not disclose any particular operation in response to a “wrong number” as suggested by the Examiner, nor is it shown that any such operation would be an inherent part of the operation of *Vaziri*. Thus, *Vaziri* does not disclose, expressly or inherently, “determining whether the code is invalid” or “disconnecting the communication channel between the first station and the data network, in response to determining that the code is invalid” as recited by Claim 55.

As a result, *Vaziri* fails to disclose, expressly or inherently, every element of Claim 55. Claim 55 is thus allowable for at least these reasons. Applicants respectfully request reconsideration and allowance of Claim 55 and its dependents.

With respect to Claim 61, the Examiner notes only that “Claim 61 is similar to claims 16 and 57 or 59.” *Office Action*, p. 4. Although of differing scope from Claim 16, Claim 61 includes particular elements that, for one or more reasons substantially similar to those discussed above with respect to Claim 16, are not disclosed by the cited references. For example, Claim 61 recites, *inter alia*, “receiving, at a second station, a code transmitted by a first station” and “identifying, at the second station, the data network address of the first station based on at least the code.” As noted above with respect to Claim 16, *Vaziri* fails to disclose at least these elements of amended Claim 61.

As a result, *Vaziri* fails to disclose, expressly or inherently, every element of amended Claim 61. Claim 61 is thus allowable for at least these reasons. Applicants request reconsideration and allowance of Claim 61 and its dependents.

Section 103 Rejections

The Examiner rejects Claims 20-21, 24, 60 and 62 under 35 U.S.C. § 103(a) as being unpatentable over *Vaziri* in view of U.S. Patent No. 6,430,178 issued to *Yahiro* (“*Yahiro*”). In rejecting Claims 21, 60, and 62, the Examiner takes Official Notice of particular elements of those claims that the Examiner asserts are well-known. Specifically, the Examiner states that “a method and system for selecting a provider for establishing a communication channel via PSTN from a list of providers that [is] associated with the first station is well known and expected in the art of the time of invention was made.” *Office Action*, p. 6. Applicants respectfully traverse this Official Notice and disagree with the Examiner regarding the alleged notoriety of these elements. If the Examiner intends to continue to rely on this Official Notice in rejecting any claims, Applicants respectfully request the Examiner to cite a reference or provide a signed affidavit in support of Examiner's position. *See* MPEP § 2144.03.

Furthermore, in rejecting Claim 24, the Examiner also takes Official Notice of particular elements of that claim that the Examiner asserts are well-known. Specifically, the Examiner states that “a method and system for using voice signal as a command signal as a request signal is well known and expected in the art.” *Office Action*, p. 6. Applicants respectfully traverse this Official Notice and disagree with the Examiner regarding the alleged notoriety of these elements. If the Examiner intends to continue to rely on this Official Notice in rejecting any claims, Applicants respectfully request the Examiner to cite a reference or provide a signed affidavit in support of Examiner's position. *See* MPEP § 2144.03.

Nonetheless, Claims 20-21 and 24 depend from Claim 16, while Claims 60 and 62 depend from Claim 58. Claims 20-21, 24, 60 and 62 are thus allowable for at least these reasons. Applicants respectfully request reconsideration and allowance of Claims 20-21, 24, 60 and 62.

The Examiner rejects Claim 29 under 35 U.S.C. § 103(a) as being unpatentable over *Ménard*. In rejecting Claim 29, the Examiner takes Official Notice of particular elements of that claim that the Examiner asserts are well-known. Specifically, the Examiner states “that a method and system for selecting a provider for establishing a communication channel via PSTN from a list of providers that [is] associated with the first station is well known and

expected in the art of the time of invention was made.” *Office Action*, p. 7. As noted above with respect to similar statements by the Examiner regarding Claims 21, 60, and 62, Applicants respectfully traverse this Official Notice and disagree with the Examiner regarding the alleged notoriety of these elements. If the Examiner intends to continue to rely on this Official Notice in rejecting any claims, Applicants respectfully request the Examiner to cite a reference or provide a signed affidavit in support of Examiner's position. *See* MPEP § 2144.03. However, for the purposes of advancing prosecution, Applicants cancel Claim 29, thereby obviating the Examiner's rejection of this Claim.

The Examiner rejects Claims 30-41 under 35 U.S.C. § 103(a) as being unpatentable over PCT Published Application No. WO98/11704, Gordon (“*Gordon*”) in view of *Vaziri*. As amended, Claim 30 recites:

A first station for initiating voice communication with a second station over a first network and a second network, the first station being a telephonic device comprising:

a storage medium having stored therein a plurality of programming modules including a code module and a call initialization module, wherein the call initialization module is operable to initiate a call to a second station over a first network; and

a single activation means for causing the code module to transmit a code to the second station when the single activation means has been activated, the code routing over the first network, wherein the call initialization module of the second station is operable to, in response to receiving the code, transmit an establish-communication-channel command which causes a communication channel to be established between the first and second stations over a second network based at least in part on the code, and if said single activation means has not been activated, the communication channel being established between the first and second stations over the first network, wherein the first network comprises a circuit switched network.

Gordon and *Vaziri*, both alone and in combination, fail to disclose, teach, or suggest every element of amended Claim 30 for at least several reasons. First, the proposed *Gordon-Vaziri* combination fails to disclose “a single activation means for causing the code module to transmit a code to the second station when the single activation means has been activated.” Second, the proposed *Gordon-Vaziri* combination also fails to disclose “the call initialization module of the second station is operable to, in response to receiving the code, transmit an establish-communication-channel command which causes a communication channel to be established between the first and second stations over a second network based at least in part

on the code.” For at least these reasons, as described in greater detail below, the proposed *Gordon-Vaziri* combination fails to disclose every element of amended Claim 30.

First, the proposed *Gordon-Vaziri* combination fails to disclose “a single activation means for causing the code module to transmit a code to the second station when the single activation means has been activated.” In addressing this element of Claim 30, the Examiner references step 442 in Figure 5b of *Gordon*. The text associated with that step states merely that “if the recipient has not yet pick up the phone and the appliance detects that the caller is an appliance user by checking its internal phonebook in step 442, the recipient’s appliance will wait until the ringing stops in step 446.” P. 15. The Examiner, however, has failed to identify a “single activation means for causing the code module to transmit a code to the second station” and, more specifically, any single activation means that transmits the code “when the single activation means has been activated” as required by Claim 30. Thus, the proposed *Gordon-Vaziri* combination fails to disclose this element of Claim 30.

Second, the proposed *Gordon-Vaziri* combination also fails to disclose “[a] call initialization module of the second station . . . operable to, in response to receiving the code, transmit an establish-communication-channel command which causes a communication channel to be established between the first and second stations over a second network based at least in part on the code.” As the Examiner concedes, *Gordon* fails to disclose this element of Claim 30. *Office Action*, p. 8. Instead, in addressing this element of Claim 30, the Examiner references Figure 9A of *Vaziri*, noting that “the second station retrieves IP address of first station and establishes a communication channel to the first station.” *Office Action*, p. 8. To whatever extent this may be true, the Examiner has identified “the telephone number of the first station” as the “code” that is “transmit[ted] . . . to the second station,” not the IP address of the first station. Because, in the cited portion of *Vaziri*, the second ISB attempts to contact the first ISB using the IP address of the first ISB, not the telephone number, the second ISB does not, “in response to receiving the code, transmit an establish-communication-channel command,” nor does the second ISB “cause a communication channel to be established between the first and second stations over a second network based at least in part on the code” as recited by Claim 30. Thus, the proposed *Gordon-Vaziri* combination also fails to disclose “[a] call initialization module of the second station . . . operable to, in response to receiving the code, transmit an establish-communication-channel

command which causes a communication channel to be established between the first and second stations over a second network based at least in part on the code.”

Furthermore, Applicants respectfully note that, to establish a *prima facie* case of obviousness, the Examiner must identify within the references some suggestion or motivation to combine the references. M.P.E.P. § 2143. Applicants respectfully assert that the Examiner provides no such suggestion or motivation. With respect to the proposed combination, the Examiner states only that:

[I]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for allowing the second station to retrieve an IP address of the first station and using it to establish a communication between them as disclosed by Vaziri into Gordon. The motivation would have been to prevent loss call [sic].

Office Action, p. 8.

Nonetheless, Applicants find no reference to lost calls in either *Vaziri* or *Gordon*. Moreover, Applicants respectfully submit that these conclusory statements identify no motivation or suggestion within the references to combine the references as required by M.P.E.P. § 2143 and amount to hindsight reconstruction of Claim 30. Thus, the proposed combination is improper.

Consequently, the proposed *Gordon-Vaziri* combination fails to disclose, teach, or suggest every element of amended Claim 30. The proposed *Gordon-Vaziri* combination is also improper. Claim 30 is thus allowable for at least these reasons. Applicants respectfully request reconsideration and allowance of Claim 30 and its dependents.

In addition, in rejecting Claim 36, the Examiner takes Official Notice of particular elements of that claim that the Examiner asserts are well-known. Specifically, the Examiner states that “a method and system for selecting a provider for establishing a communication channel via PSTN from a list of providers that associated with the first station is well known and expected in the art of the time of invention was made.” *Office Action*, p. 9-10. Applicants respectfully traverse this Official Notice and disagree with the Examiner regarding the alleged notoriety of these elements. If the Examiner intends to continue to rely on this Official Notice in rejecting any claims, Applicants respectfully request the Examiner to cite a reference or provide a signed affidavit in support of Examiner's position. *See* MPEP § 2144.03.

Furthermore, in rejecting Claim 40, the Examiner also takes Official Notice of particular elements of that claim that the Examiner asserts are well-known. Specifically, the Examiner states that “IVR is well known and expected in the art at the time of invention was made.” *Office Action*, p. 10. Applicants respectfully traverse this Official Notice and disagree with the Examiner regarding the alleged notoriety of these elements. If the Examiner intends to continue to rely on this Official Notice in rejecting any claims, Applicants respectfully request the Examiner to cite a reference or provide a signed affidavit in support of Examiner's position. *See* MPEP § 2144.03.

The Examiner rejects Claims 50-51 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,078,579 issued to Weingarten (“*Weingarten*”) in view of U.S. Patent No. 6,584,094 issued to Maroulis et al. (“*Maroulis*”). Claim 50 recites:

A method for establishing voice communication between a first station and a second station using a first network and a second network, the method comprising the steps of:

receiving a data network address for a first station at a second station via a first communication channel in a first network, the data network address identifying the first station;

determining whether the first station and the second station can support a communication channel for voice communication over the second network;

disconnecting the first station and the second station from the first communication channel, in response to determining that the first station and the second station support voice communication over the second network;

initiating a second communication channel over the second network between the first station and the second station for voice communication, based on at least the data network address received at the second station;

determining whether the first station and the second station have established the second communication channel over the second network; and

establishing a third communication channel between the first station and the second station using a circuit switched network, in response to determining that the first station and the second station have not established the second communication channel over the second network.

Weingarten and *Maroulis*, both alone and in combination, fail to disclose, teach, or suggest every element of Claim 50 for at least several reasons. First, the proposed *Weingarten-Maroulis* combination fails to disclose “determining whether the first station and the second station can support a communication channel for voice communication over the second network.” Second, the proposed *Weingarten-Maroulis* combination fails to disclose “disconnecting the first station and the second station from the first communication channel, in response to determining that the first station and the second station support voice

communication over the second network.” Third, the proposed *Weingarten-Maroulis* combination fails to disclose “determining whether the first station and the second station have established the second communication channel over the second network” and “establishing a third communication channel between the first station and the second station using a circuit switched network, in response to determining that the first station and the second station have not established the second communication channel over the second network..” For at least these reasons, as described in greater detail below, the proposed *Weingarten-Maroulis* combination fails to disclose every element of amended Claim 50.

First, the proposed *Weingarten-Maroulis* combination fails to disclose “determining whether the first station and the second station can support a communication channel for voice communication over the second network.” As the Examiner concedes, *Weingarten* fails to disclose this element of Claim 30. *Office Action*, p. 11. With respect to *Maroulis*, the Examiner indicates that *Maroulis* “discloses a method and system for . . . determining if both location can support voice over internet (Fig 2c, Ref 225) by the first location signaling to the second location and waiting for a response from the second location (Fig 2, Ref 215 and 225).” *Office Action*, p. 11. Applicants respectfully contest this assertion as *Maroulis* clearly indicates that “the second PBX performs a test to ascertain whether or not it is coupled to a second gateway 111. If not, the second PBX does not send a response packet to the first PBX . . .” Col. 6, ll. 31-34. Thus, contrary to the Examiner’s assertion, the transmission of a response by the second PBX indicates whether or not the second PBX is coupled to a second gateway, not “whether the first station and the second station can support a communication channel for voice communication over the second network.” As a result, the proposed *Weingarten-Maroulis* combination fails to disclose “determining whether the first station and the second station can support a communication channel for voice communication over the second network” as recited by Claim 50.

Second, the proposed *Weingarten-Maroulis* combination fails to disclose “disconnecting the first station and the second station from the first communication channel, in response to determining that the first station and the second station support voice communication over the second network.” Applicants respectfully note that the Examiner fails to address this element in rejecting Claim 50. Moreover, neither *Weingarten* nor *Maroulis* individually disclose “disconnecting the first station and the second station from the

first communication channel, in response to determining that the first station and the second station support voice communication over the second network.” Thus, the proposed *Weingarten-Maroulis* combination also fails to disclose “disconnecting the first station and the second station from the first communication channel, in response to determining that the first station and the second station support voice communication over the second network.”

Third, the proposed *Weingarten-Maroulis* combination fails to disclose “determining whether the first station and the second station have established the second communication channel over the second network” and “establishing a third communication channel between the first station and the second station using a circuit switched network, in response to determining that the first station and the second station have not established the second communication channel over the second network..” In addressing these elements, the Examiner cites a portion of *Weingarten* that merely discloses that the claimed method for providing a voice communications path over an internet “wherein the voice communications path includes two internet channels between the first internet gateway device and the second internet gateway device, and allows voice communications between the first POTS telephone and the second POTS telephone.” Col. 7, 63-67. The cited portion, however, fails to disclose any manner of “determining whether the first station and the second station have established the second communication channel over the second network” and “establishing a third communication channel . . . in response to determining that the first station and the second station have not established the second communication channel over the second network.”

Furthermore, Applicants respectfully reiterate that, to establish a *prima facie* case of obviousness, the Examiner must identify within the references some suggestion or motivation to combine the references. M.P.E.P. § 2143. Applicants respectfully assert that the Examiner provides no such suggestion or motivation. With respect to the proposed combination, the Examiner states only that:

[I]t would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system signaling between the first and second to determining if they support voice over IP or not as disclosed Maroulis [sic] into the system and method of Weingarten. The motivation would have been to reduce the cost for the customers.

Office Action, p. 8.

Nonetheless, Applicants find, within the relevant references, no indication of how the proposed changes to the *Vaziri* and *Gordon* systems might possibly reduce cost to customers. While features of the *Vaziri* and *Gordon* systems are identified within the respective references as allegedly reducing costs for customers, there is no indication in either reference that the proposed changes would reduce costs to customers and, moreover, the Examiner has himself provided no explanation of how such changes might possibly reduce costs. As a result, Applicants respectfully submit that the Examiner's conclusory statements identify no motivation or suggestion within the references to combine the references as required by M.P.E.P. § 2143 and amount to hindsight reconstruction of Claim 50. Thus, the proposed combination is improper.

Consequently, *Vaziri* and *Gordon*, both individually and in combination, fail to disclose, teach, or suggest every element of Claim 50. Additionally, the proposed *Weingarten-Maroulis* combination is improper. Claim 50 is thus allowable for at least these reasons. Applicants respectfully request reconsideration and allowance of Claim 50 and its dependents.

Conclusions

Applicants have made an earnest attempt to place this case in condition for allowance. For the foregoing reasons, and for other reasons clearly apparent, Applicants respectfully request full allowance of all pending Claims. If the Examiner feels that a telephone conference or an interview would advance prosecution of this Application in any manner, the undersigned attorney for Applicants stands ready to conduct such a conference at the convenience of the Examiner.

No fees are believed to be due, however, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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